

ATTORNEY DOCKET NO. 05125.0001U1
Application No. 09/944,288

REMARKS

The Applicant respectfully requests reconsideration of the present application in view of the above changes to the claims and the following remarks, which are responsive to the Non-Final Office Action mailed December 15, 2009.

I. Examiner Interview

Applicant would first like to thank the Examiner for conducting an interview with Applicant's representative to discuss the Office Action, the references cited therein, and proposed claim amendments for filing in response to the Office Action. During the interview, the Examiner agreed that the proposed amendments, which have been adopted in this response and are listed above, overcome the prior art. In particular, as shown above, the claims have been amended in order to clarify that the diskless host that is automatically configured upon being physically connected to the network "was not previously connected to the network." The Examiner agreed that this feature distinguishes the claimed invention over the cited prior art.

During a subsequent email correspondence following the interview, a copy of which is attached hereto, the Examiner further agreed that there was sufficient support in Applicant's specification as filed to support the proposed amendments. In particular, Applicant's representative pointed to at least page 2, lines 9-11; page 9, lines 6-8; page 3, lines 16-17; and page 11, lines 2-4 of Applicant's specification as supporting the proposed amendments. The Examiner agreed, stating that "taking into consideration one [of] ordinary skill in the art, it appears that the proposed amendment is supported by the specification and overcomes the cited prior art." (January 14, 2010 Email).

II. Status of the Claims

In the Office Action, Claims 5, 6, 11, 12, 14-16 and 22-27 were noted as pending in the application and were rejected. As a result of this response, Claim 14 has been canceled, Claims 5, 6, 11, 12, 15, 16 and 22-27 remain pending and Claims 12, 15, 22 and 23 have been amended in order to further clarify the claimed invention.

III. Claim Rejections

a. 35 U.S.C. § 112

In the Office Action, Claims 5, 6, 11, 12, 15, 16 and 22-27 were rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action, page 2). In particular, the Office Action objects as unclear and indefinite the following recitation of Claims 12, 22 and 23: “the operating system copied to the storage device from another device of the storage system is altered based on one or more requirements associated with the diskless host computer.” (*Id.*). In response, Applicant has amended Claims 12, 22 and 23, as shown above, to remove this recitation. Accordingly, Applicant respectfully requests that the § 112 rejection of Claims 5, 6, 11, 12, 15, 16 and 22-27 be withdrawn.

b. 35 U.S.C. § 103(a)

In the Office Action, Claims 5, 12, 15, 22-24, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,834,299 issued to Hamilton, II et al. (“*Hamilton*”) in view of U.S. Publication 2001/0047460 issued to Kobayashi et al. (“*Kobayashi*”) in further view of U.S. Patent No. 7,082,462 issued to Matsunami et al. (“*Matsunami*”) in further view of U.S. Patent No. 6,167,494 issued to Cheston et al. (“*Cheston*”), and further in view of U.S. Patent No. 6,292,941 to Jollands (“*Jollands*”). (Office Action, page 3). In addition, Claims 6 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hamilton* in view of *Kobayashi*, *Matsunami* and *Cheston*, and in further view of U.S. Patent No. 6,810,478 issued to Anand et al. (“*Anand*”). (*Id.* at page 12). Finally, Claims 11 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hamilton* in view of *Kobayashi*, *Matsunami* and *Cheston*, and in further view of U.S. Patent No. 6,343,287 issued to Kumar et al. (“*Kumar*”). (*Id.* at page 13).

As noted above, during an interview and subsequent email correspondences, the Examiner agreed that none of the cited references teach or suggest automatically configuring a diskless host computer that “was not previously connected to the network,” as recited in Applicant’s independent Claims 12, 22 and 23, as amended. The Examiner further agreed that Applicant’s specification, and in particular, page 2, lines 9-11; page 9, lines 6-8; page 3, lines 16-

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17; and page 11, lines 2-4 of Applicant's specification as filed, provide ample support for this recitation. Accordingly, Applicant respectfully asserts that independent Claims 12, 22 and 23 are patentable over the cited prior art and respectfully requests that the § 103(a) rejection of these claims be withdrawn.

Dependent Claims 15 and 16; 5, 6 and 11; and 24-27 depend, respectively, from independent Claims 12, 22 and 23 and include all of the recitations of their base claims and any intervening claims plus their additional recitations that further distinguish the art applied in the rejection. Thus, for at least the reasons set forth above with respect to independent Claims 12, 22 and 23, it is respectfully submitted that dependent Claims 5, 6, 11, 15, 16 and 24-27 are further patentable over the references cited in the Office Action as such dependent claims now depend from allowable base claims

IV. Conclusion

In light of the remarks above, Applicant respectfully submits that the application is in condition for allowance and respectfully requests that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 14-0629.

Respectfully submitted,

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Miller, Jennifer F. (Atlanta)

From: Tiv, Backhean [Backhean.Tiv@USPTO.GOV]
Sent: Thursday, January 14, 2010 9:35 PM
To: Miller, Jennifer F. (Atlanta)
Subject: RE: Appln. No. 09/944,288 (Atty. Dkt. No. 05125.0001U1)

Ms. Miller,

I had a chance to look at the sections cited in detail, as well as your argument; and taking into consideration one ordinary skill in the art, it appears that the proposed amendment is supported by the specification and overcomes the cited prior art. However, I am still required to do an updated search in order to determine patentability when you formally submit the amendments and arguments.

If you have any other questions/concerns, I can be reached at (571) 272-5654 or through email.

Sincerely,

Backhean Tiv

From: Miller, Jennifer F. (Atlanta) [mailto:millerjf@ballardspahr.com]
Sent: Wednesday, December 30, 2009 1:43 PM
To: Tiv, Backhean
Subject: Appln. No. 09/944,288 (Atty. Dkt. No. 05125.0001U1)

Examiner Tiv,

Thank you again for conducting an interview with me earlier today. As I mentioned, I have reviewed the specification again for additional support for the proposed claim amendments. In addition to Page 2, lines 9-11 and Page 9, lines 6-8, I would like to point out Page 3, lines 16-17, which state that "Configurations corresponding to all types of hosts *expected to be connected to the network* are pre-stored in the SAN data storage system," as well as Page 11, lines 2-4, which refers to the installation of software and configuring a "new host."

Basically, the combination of all of these excerpts would imply to a person of ordinary skill in the art that the claimed invention addresses how to install a *new* device to the network - i.e., a device that was not previously part of the network. And in order to be able to do that, the database includes a correspondence between the WWN of devices *likely to be or expected to be* connected to the network (i.e., not previously part of the network) and the configuration data for that device.

Please let me know if you have any questions or would like to discuss further. Otherwise, I look forward to hearing from you after you have had a chance to review further.

Thank you again!

Kind regards,
Jennifer

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The name of the firm has changed. Ballard Spahr Andrews & Ingersoll, LLP is now Ballard Spahr LLP. All other information remains the same. Please update your records. Thank you.